

In re Application of:
Pandian et al.
Application No.: 09/940,296
Filed: August 27, 2001
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PATENT
Attorney Docket No.: MBM1270

REMARKS

Upon the entry of the amendment, claims 1-4, are pending and at issue. Claim 1 has been amended to claim the subject matter of the invention with greater particularity and specificity. Claims 25-29 are cancelled without prejudice or disclaimer. Claims 5-24 were previously withdrawn.

I. Amendment to the claims

Claim 1 has been amended. Support for the amendment can be found throughout the specification, for example, support for a single-stranded amplification probe can be found at least on page 17, lines 16 – 17.

Hence, the amendment does not add new matter, and its entry and consideration is respectfully requested.

II. Rejections under 35 U.S.C. § 102

Claims 1-4 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,656,731 to Urdea et al. (1997; hereinafter, "Urdea"). Applicants respectfully traverse this rejection as follows.

To anticipate, a single reference must inherently or expressly teach each and every element of claimed invention. *In re Spada*, 15 USPQ2d 1655 (Fed Cir. 1990); and *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131.

Urdea discloses hybrid probes comprising nucleic acid and polypeptide sequences which are used to amplify the detectable signal in immunoassays. Without conceding to the correctness of the Office Action's rejection and solely in order to expedite prosecution of the instant

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application, Applicant submits amended claim 1, directed to a single-stranded amplification probe. Applicant submits that Urdea cannot anticipate the claimed invention because Urdea does not disclose or teach each and every element of the claimed invention. Further, claims 2-4, by being dependent on claim 1, are also not anticipated by Urdea.

Accordingly, withdrawal of rejection of claims 1-4 under 35 U.S.C. § 102(e) is respectfully requested.


Conclusion

In view of the amendments and above remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application.

Applicants do not believe any other fees are due in connection with this submission, however if any other fees are due, please charge any fees, or make any credits, to Deposit Account No. 07-1896.

Respectfully submitted,

Date: October 6, 2005



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